REMARKS

Pending Claims

Claims 1-18 are still pending, and new claims 19 and 20 have been added.

Response to Argument

The applicants first wish to thank the Examiner for giving them the opportunity to respond to the new line of rejection, without having to file a Request for Continued Examination just to respond to prior art they'd never seen before. Even though this is appropriate, and follows the letter and spirit of the MPEP, this has unfortunately become an increasingly rare courtesy.

Claim Rejections – 35 USC §112

The Examiner rejected claim 1 (and its dependent claims) because of the phrase "and/or" within the larger phrase "after handling by the originator and/or user." The phrase has been amended to state "after handling by the user," with no "and/or." Paragraph [0087] of the specification makes clear that "the originator and the user may be the same."

Claim Rejections – 35 USC §103

All three of the independent claims 1, 12 and 18 stand rejected as being obvious and therefore unpatentable over a hypothetical combination of systems disclosed in published patent application US 20030033167 (*Light*) and issued patent US 6,192,380 (*Maxwell*).

In both cases, *Light* and *Maxwell* relate to the feature commonly referred to as "auto-fill" used when completing forms displayed by a web browser. As with any other of the many such applications, a user will initially enter items of information, such as an e-mail address, credit card type and number, etc., that are to be applied as entries to corresponding input fields (not only for text input, but also for such on-screen devices as radio buttons) on a on-screen displayed form.

In short, when a user selects (such as by downloading) a form, he will not need to manually complete any data field for which information has been previously stored. The information that is pre-stored can have been obtained either through deliberate, manual entry into corresponding fields of an "auto-fill" display, or through automatic capture when the user filled in the same data field (having a label from a set of equivalent labels) in some previous form. The entire purpose of both *Light* and *Maxwell*, as well as of other auto-fill routines, is to avoid duplication of effort in data entry – the user need only enter the 16 digits of a credit card once, for example. *Maxwell* further addresses the issue of data security, but the fundamental operation of *Maxwell* is the same as for other auto-fill applications.

Assume now that a user enjoyed a particular book B, which he earlier ordered through the on-line site of a particular vendor V, by filling out and submitting an on-line order form F. Now the user wants to order a second copy of B from the same vendor V. He thus logs into S, selects B, and is presented with form F when he goes to "Checkout." This is of course a common procedure, familiar to countless modern computer users, in fact, to almost everybody who has ever ordered anything on-line.

Using the auto-fill feature of *Light* or *Maxwell*, the user could avoid having to re-enter such information as his name, shipping address, credit card type, number and expiration date, etc. Even up to the point when the user clicks on "Submit" (or "Order" or "Pay" or some similar "transaction-finalizing" icon), however, there is absolutely nothing to distinguish a current instance of the completed form from the previous instance of the form. Thus, in auto-fill systems such as *Light's* and *Maxwell's*, the user or the system might automatically enter into data fields that uniquely identify the form ***requestor,*** or ***type*** of form (for example, order form as opposed to a change of account form) but neither reference teaches uniquely identifying different ***instances*** of a single form. In other words, *Light* and *Maxwell* might fairly be said to provide for submission of some type of information (such as name coupled with a credit card number) that is ***requestor***-specific (perhaps uniquely identifying) the *person* submitting the form), but they fail to teach (see claims 1, 12 and 18) "generating a ***request***-specific identifier uniquely identifying the ***instance*** of the requestor-specific form."

To the extent *Light* and *Maxwell* provide for any type of form identification at all, such identification is a) not request-specific; and b) is not generated, but rather presupposes current or past user input and is at best simply copied in.

Paragraphs [0064] and [0065] of the specification explain, in pertinent part:

> In the context of this embodiment, a "form" is one or more documents, however created, which, at at least one point from the time of generation to final processing, is assumed to be printed or rendered in some form that allows a user to make markings, add text, sign, or the like, in some manner that presupposes intervention and processing by some form of print driver, whether for printing onto paper, to a fax modem, to a document capture routine, etc., and which is intended to be returned to a form originator for ultimate processing ....
>
> In other words, a form (which includes the information entered into or on it) in the sense used here involves at least one change of medium or format, such as from an HTML, XML, or similar network (for example, Internet) format to fax, from fax to paper and/or vice versa, from web to paper and/or vice versa, from web to fax modem or document capture format and/or vice versa, etc.

This distinction (medium or format transformation) is now expressly recited generally in the amended independent claims (and specifically in claims 19 and 20) through addition of phrases relating to the different transmission modes in which the form is requested (presented in some way to the originator, who of course may be the same as the user) as opposed to being received for final processing (including routing). This feature is not disclosed in *Light* or *Maxwell* or, in any other of the cited prior art references. In both *Light* and *Maxwell*, it is assumed throughout that the form the user intends to complete and submit will be transmitted back over both the same medium (such as the Internet) and in the same file or transfer format (such as html, with or without embedded scripting) it was downloaded in, regardless of whether some other type of routine (such as Java) is used to implement the disclosed auto-fill steps. Indeed, the examiner is correct in stating that "several different types of files" such as those used in *Maxwell* "may be displayed using a web browser," but display mode alone is beside the point of this invention.

The value of the applicants' invention – and the unique features that provide this value – can be illustrated with a couple of examples. First, assume that a university professor wishes to allow students to take a test outside the classroom, but, to reduce the likelihood of cheating, he wants to send different versions of tests to different students. He therefore wants to make the different versions of the test available on-line to the students, who will then print out the test (using, for example, either a paper or pdf or other print driver), sign the test, and send it back to the university's server, either using a fax machine, or perhaps as a pdf e-mail attachment, etc.

Using *Light* and *Maxwell*, the students themselves would need to know which test to request when logging into the university's server. Using the applicants' invention, however, each *instance* of the on-line test form presented to the student would be uniquely identified upon printing (including electronic) of the form, and the university's server would know that the particular student had downloaded the particular version of the exam. Thus, there will be no confusion as to which instance of a test a particular student downloaded and took. Students would also not be able to "exchange" test forms, since each instance will already have been uniquely associated with a particular requestor. Depending on the chosen transmission modes, the invention would also allow the student to access her test form on-line (for example, as an html form), then complete it, print it out on paper for signature (not possible using the single-mode systems of *Light* and *Maxwell*), and then fax the completed, signed test back to the university. The unique identifier would "follow" the *instance* of the form, regardless of which format the form is in or over which medium it's transmitted. *Light* and *Maxwell* both lack not only the invention's level of flexibility, but also it's degree of document-handling efficiency and freedom from ambiguity.

Another example of the advantage of the applicants' invention also shows how it can eliminate the potentially more serious problem of duplication. Assume that a patient needs a patented (single-vendor) prescription drug, and goes to a doctor to get the prescription filled. The doctor, also entering the patient's name, could download a form for ordering the drug, but as soon as he prints it out, perhaps for faxing to a pharmacy,

the invention could uniquely identify the *instance* of the form and flag that a different instance of the form had already been generated for the same patient. Any attempt to download the same order form for the same drug for the same patient could therefore be detected *before* submission of the duplicate order, thereby avoiding potentially filling two orders. Even the act of requesting a second order form for the drug for the same patient could be flagged (note again: the identifier is ***request***-specific but the form itself is ***requestor***-specific).

Another way to see the difference between the applicants' invention and all auto-fill systems such as *Light* and *Maxwell* is to consider that the systems disclosed in those references could optionally be included in a system that also implements the applicants' invention. However, just because auto-fill is used to help fill in a form has nothing to do with either the generation of a unique, *request*-specific identifier of an instance of the form that is filled in, or any transformation of medium or format. In other words, a system such as *Light's* or *Maxwell's* could be included as an optional convenience in the computer of the user of at least some embodiments of the applicants' invention (those in which the form is downloaded and can be filled in on-screen), but it would be unnecessary for proper use of the invention and is unrelated to the features of the applicants' invention that make it unique and patentable.

The independent claims as amended therefore recite features of the applicants' invention that are not disclosed in either *Light* or *Maxwell* and that provide clear technical benefits that *Light* and *Maxwell* both fail not only to provide but even to anticipate and mention. The independent claims should therefore be allowable over the cited prior art.

As for the dependent claims, these should also be allowable along with their respective independent base claim. The applicants wish to point out in particular, however, that neither *Light* nor *Maxwell* have any provision for auto-filling or in any other way handling or incorporating any processing of handwritten information, as recited in claims 7 and 8, since they fail to provide for any kind of multi-medium or multi-format processing at all.

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